

REMARKS

STATUS OF THE CLAIMS

In accordance with the foregoing, claims 1-3, 6-12 and 15-21 have been amended. Claims 1-21 are pending and under consideration.

No new matter is being presented, and approval of the amended claims is respectfully requested.

REASONS FOR ENTRY

Applicants request entry of this Rule 116 Response and Request for Reconsideration because the amendments of claims 1-3, 6-12 and 15-21 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised. The amendments were not earlier presented because the Applicants believed in good faith that the cited prior art did not disclose the present invention as previously claimed;

Further, the amendments do not significantly alter the scope of the claims and place the application at least into a better form for appeal. The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTION OF CLAIMS 1-11, 15-19 AND 21 FOR OBVIOUSNESS UNDER 35 U.S.C § 103(a) AS BEING UNPATENTABLE OVER PEINADO ET AL. (U.S. PATENT NO. 6,772,340 B1) IN VIEW OF SPRUIT ET AL. (U.S. 2002/0030932)

The rejections of claims 1-21 are respectfully traversed and reconsideration is requested.

Peinado et al. (hereinafter "Peinado") teaches a contents processing method by which the extracted contents are encrypted and made accessible over the internet in encrypted form. However, according to the Abstract in Peinado, the content server may also supply the encrypted content on an optical disk or the like. The device in Peinado does not necessarily record the desired contents on a user medium; thus, encryption of contents based on an identifier having been given to a medium, as claimed in the present invention, is theoretically impossible.

As noted by the Examiner on page 3 of the Action, Peinado fails to teach encrypting digital content based on an identifier having been given uniquely to a medium. Hence, the Examiner cites Spruit et al. (hereinafter "Spruit") as disclosing this feature.

Spruit discloses a rewritable data-storage medium on which copy-protected content may be *recorded by a manufacturer* and encrypted with a key that is based on an identification mark written on the medium during production. ([0029]).

In contrast, in the present invention, contents requested by the user are recorded in an optional medium prepared by the user. For example, amended claim 1 recites, extracting the stored contents, as requested by the user; encrypting the extracted contents, based on an identifier having been given uniquely to an optional medium prepared by the user; and recording the encrypted contents on the medium prepared by the user.

Therefore, it is respectfully submitted that neither Peinado nor Spruit, alone or in combination, teaches or suggests the features of amended independent claim 1, as described above.

Similarly, independent claims 2, 7, 8, 10, 15-19 and 21 are amended herein to further clarify that contents *requested by a user* are encrypted based on an identifier having been given uniquely to *an optional medium prepared by the user*. Accordingly, it is respectfully submitted that independent claims 2, 7, 8, 10, 15-19 and 21 patentably distinguish over the prior art.

Dependent claims 2-6, 9 and 11 inherit the patentable recitations of their respective base claim and, thus, it is respectfully submitted that claims 2-6, 9 and 11 patentably distinguish over the prior art.

Furthermore, the Examiner has not established a *prima facie* case of obviousness by combining Peinado with Spruit, since there is no suggestion or motivation to modify these references. MPEP § 2143.01 states, "the prior art must suggest the desirability of the claimed invention".

In this case, Peinado teaches encrypting content based on a hidden watermark within the content. Thus, the content in Peinado is already in encrypted form before being distributed.

Therefore, there is no suggestion or motivation to modify Peinado by encrypting the content based on the identification mark of the recording medium, as disclosed by Spruit, since the content in Peinado is already encrypted before being distributed.

Moreover, MPEP § 2143.01 states that the mere fact that the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness.

Therefore, assuming, *arguendo*, that the references teach all the individual elements of the present invention, the Examiner has still not established a *prima facie* case of obviousness

without some objective reason to combine the teachings.

REJECTION OF CLAIMS 12-14 AND 20 FOR OBVIOUSNESS UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER PEINADO AND SPRUIT AND FURTHER IN VIEW OF TANAKA (U.S. 2003/0208766 A1)

The rejections of claims 12-14 and 20 are respectfully traversed and reconsideration is requested.

Independent claim 12 is amended herein to recite accepting first specifying information for specifying contents requested by the user, second specifying information for specifying another computer in which the contents are to be recorded and an identifier having been given uniquely to each optional medium prepared by the user, transmitted from the outside. Therefore, for at least the reasons provided above, it is respectfully submitted that independent claim 12 patentably distinguishes over the prior art.

Similarly, independent claim 20 is amended to recite accepting first specifying information for specifying contents requested by the user, second specifying information for specifying another computer in which the contents requested by the user are to be recorded, and an identifier having been given uniquely to each optional medium prepared by the user, transmitted from the outside. Therefore, it is respectfully submitted that independent claim 20 patentably distinguishes over the prior art.

Claims 13 and 14 depend from claim 12 and inherit the patentable recitations thereof. Thus, it is respectfully submitted that claims 13 and 14 patentably distinguish over the prior art.

Tanaka is merely cited by the Examiner as disclosing another computer to receive and provide content requests to and from the requester, through a server. Therefore, it is respectfully submitted that Tanaka does not teach or suggest the features of amended independent claims 12 and 20, described above.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all pending claims patentably distinguish over the prior art. There being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

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If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

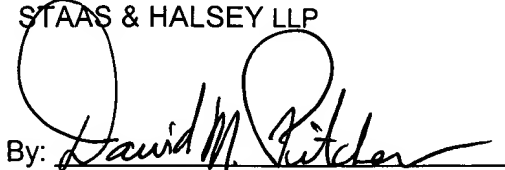
Respectfully submitted,

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